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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,910	08/20/2001	Gregory T. Whiteker	1998U020AD1.US	9327

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UNIVATION TECHNOLOGIES LLC
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EXAMINER

PASTERCZYK, JAMES W

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary

Application No.

09/932,910

Applicant(s)

WHITEKER ET AL.

Examiner

J. Pasterczyk

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/17/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13 and 15-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13 and 15-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. This Office action is in response to the amendment filed 2/17/04 and refers to the Office action mailed 11/17/03.

2. The examiner notes that the present claim 5 is annotated as being previously presented and thus not herein amended. However, in l. 2 thereof it appears as if "transition" has a line through it and thus was intended to have been deleted. It is thus not clear if this was indeed the intent since two different and contradictory writings are present.

3. Claims 1, 2 and 4-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 as now amended, the various definitions for R^1 overlap to a considerable degree, hence it is not clear just what the actual limitations on this chemical group really are. For example, R^1 may be a tertiary alkyl group as well as a C_{4-20} tertiary alkyl group; it may also be a C_{4-100} group as well as a neutral C_{4-100} group, plus it may be simply a C_{4-20} alkyl group, which can apparently be neutral or tertiary. In the second line of the second page of this claim, make "a C_4 " read --a C_4 --.

4. Claims 1, 2, 4-13 and 15-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The negative limitations found in claims 1 and 12 of "... when M is titanium, the hetero atom in R^1 and R^5 is not oxygen" and "with the proviso that M is not tungsten" (emphasis added)

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are not found in the specification and hence are new matter. These provisos are not affirmatively recited anywhere in the specification as originally filed. Instead the specification indeed discloses that the metal is preferably titanium at p. 5, l. 18. The specification itself or the claims as originally filed would have to state that these two provisos affirmatively exist in order to be properly supported in the specification.

Regarding the case law cited by applicants, *ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1986) is still found to be the case most on point with the present fact situation. The negative limitation at issue there is the phrase "said catalyst being free of uranium and the combination of vanadium and phosphorus". From the case it is apparent that this phrase was added to avoid prior art rejections made during prosecution on the merits. The Board found that these limitations "did not appear in the specification as filed" and thus "introduce[d] new concepts and violate[d] the description requirement of the first paragraph of 35 USC 112." *Grasselli*, 395. Here, the negative limitations not found in the specification as originally filed are those noted in the paragraph above. Since these introduce new concepts into the claimed invention, namely the mandatory absence of particular metals under certain circumstances, they constitute new matter. *In re Johnson*, 194 USPQ 187 (CCPA 1977) is distinguished in that a smaller subgenus of affirmatively recited specific embodiments was carved out in the claims to avoid a lost count in an interference. That is the proper manner in which to write a claim around prior art. Finally, no evidence is presented that either of these cases is no longer good law.

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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J. Pasterczyk

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3/4/04



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Supervisory Patent Examiner
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